

## REMARKS

This paper is submitted in response to the Office action mailed on February 28, 2006. This paper amends claim 1 but neither cancels existing claims nor adds new claims. Accordingly, after entry of this Amendment and Response, claims 1-16 remain pending.

### *I. Rejections Under 35 U.S.C. § 12(e): Irons*

The Examiner rejected claims 1 and 8-9 under 35 U.S.C. § 102(e) as anticipated by United States Patent No. 6,427,032 to Irons et al. (hereinafter "Irons"). For at least the following reasons, the Applicant respectfully disagrees with the rejections.

The Applicant has amended claim 1 to require a unique identifier is generated "as part of generating the form." That is, the form generation includes generation of the unique identifier.

By contrast, Irons clearly discloses that generating a form and generating a label are independent of each other. The form (i.e., document) must be generated and "meta-data" describing the document assigned to index a document. The meta-data is used to assign the document to a "pre-printed label" which is then stuck onto the document (col. 8, lines 30-49). The label is generated completely separately from the document and is not in any way linked to form generation; labels may be printed in a predetermined sequence well before documents are generated or printed: "The document identifiers,... in the most preferred embodiment *are pre-printed on labels contained in the desktop label dispenser...*" (col. 7, lines 5-10). Indeed, the entire point of Irons' invention is to attach "a *pre-printed*, globally unique document identifier to a paper-based document prior to scanning" (col. 6, lines 42-44). In order for the labels to be "pre-printed" they clearly are not generated "as part of generating the form," as required by independent claim 1.

Additionally, independent claim 1 requires the operation of "printing the form including the unique identifier." As discussed above, Irons generally teaches printing a "pre-printed label" and attaching it to a document after the document is printed (*Id.*; col. 8, lines 43-49;). Further, in claim 1 such printing must occur prior to scanning the form. Irons, by contrast, cannot print a "form including the unique identifier" until after the form is scanned, because there is no image of the form with the unique identifier attached thereto until after one scans the form. Fig. 7 clearly indicates operation 718 ("Apply Label to Document") must occur before operation 722 ("Scan/Image Documents"), which in turn must occur before operation 730 ("Retrieve Images or Paper-Based Document(s) For Use"). Only in operation 730 can a document with a label attached thereto possibly be printed, and operation 730 must occur after scanning (see *generally* col. 17, line 20 – col. 18, line 58).

The Examiner alleges Fig. 14 teaches “a form 1450 printed with text and a label 1451 on a document.” Although this is accurate, the label 1451 is placed on the document *after* the form is printed as discussed above. The Applicant further notes Irons particularly points out the label is “placed on the... document” and not printed with the document (col. 29, lines 35-38). Accordingly, Irons does not teach (and in fact teaches away from) the operation of “after printing the form including the unique identifier, scanning the form to capture information including the unique identifier” required by amended independent claim 1.

For at least the foregoing reasons, the Applicant respectfully submits Irons does not anticipate or render obvious amended independent claim 1.

Likewise, Irons does not anticipate independent claim 8. Claim 8 requires “a remote storage location driver operative to display a remote storage location as a local output device, the remote storage location driver operatively connected to the web browser and database.” There is no such remote storage location taught or suggested by Irons.

The Examiner alleges Irons discloses the particular remote storage location of claim 8 at col. 11, lines 45-56; col. 12, lines 24-45; and Fig. 2. However, these passages merely disclose a generic secondary storage. They do not disclose a driver that displays the “remote storage location as a local output device” or any type of “local device” at all. Irons teaches variously that the remote storage device may be a “series of directories or subdirectories containing a series of images” (col. 11, lines 46-52), a “Structured Query Language (SQL) database” (col. 11, lines 52-55), viewed with a web browser (col. 12, lines 24-25), and/or “large scale secondary storage” that may include “hard disk drives, recordable CD-ROM/DVD drives and jukeboxes, magnetic tapes, and other devices known to those skilled in the art” (col. 8, lines 1-7; Fig. 2). There is no teaching or suggestion that Irons’ image storage mechanism 130 may be displayed by a driver “as a local output device” as required by independent claim 8. Arguably, Irons does not specifically indicate any form of “remote” storage whatsoever.

For at least the foregoing reason, the Applicant respectfully submits Irons does not anticipate or render obvious independent claim 8.

Claim 9 depends from independent claim 8 and is therefore likewise patentable. The Applicant makes this statement without reference to or waiving the independent bases of patentability within dependent claim 9.

Accordingly, the Applicant respectfully requests the Examiner withdraw her rejections and allow claims 1 and 8-9 over the cited reference.

*II. Rejections Under 35 U.S.C. § 103*

The Examiner rejected claims 2-6 and 10-15 under 35 U.S.C. § 103(a) as unpatentable over Irons in view of United States Patent Application Publication No. 2002/0073805 to O'Day, Jr. (hereinafter "O'Day"). The Examiner also rejected claim 7 as unpatentable over Irons in view of O'Day and further in view of United States Patent Application Publication No. 2004/0260569 to Bell et al. Finally, the Examiner rejected claim 16 under 35 U.S.C. § 103(a) as unpatentable over Irons in view of O'Day and further in view of United States Patent No. 6,651,218 to Adler et al. For at least the following reason, the Applicant respectfully disagrees.

Each of rejected claims 2-7 and 10-16 depend, directly or indirectly, from one of independent claims 1 and 8. Independent claims 1 and 8 were shown to be patentable above in Section I. of this paper. Accordingly, their dependent claims are likewise patentable. The Applicant makes this statement without reference to or waiving the independent bases of patentability within each dependent claim.

Thus, the Applicant respectfully requests the Examiner withdraw her rejections of claims 2-7 and 10-16.

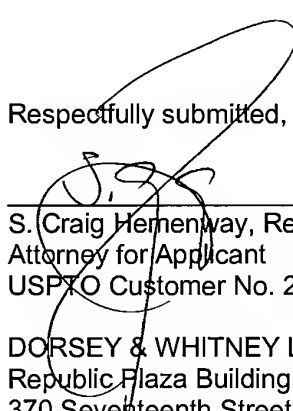
*III. Conclusion*

The Applicant believes no fees or petitions are due with this filing. However, should any such fees or petitions be required, please consider this a request therefor and authorization to charge Deposit Account No. 04-1415 as necessary.

If the Examiner should require any additional information or amendment, please contact the undersigned attorney.

Dated: 30 May 2006

Respectfully submitted,

  
S. Craig Hemenway, Registration No. 44,759  
Attorney for Applicant  
USPTO Customer No. 20686

DORSEY & WHITNEY LLP  
Republic Plaza Building, Suite 4700  
370 Seventeenth Street  
Denver, Colorado 80202-5647  
Phone: (303) 629-3400  
Fax: (303) 629-3450